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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JUNE R. HEROLD

Appeal 2015-008281
Application 13/423,001
Technology Center 2400

Before ERIC S. FRAHM, LINZY T. McCARTNEY, and
JOHN D. HAMANN, *Administrative Patent Judges*.

McCARTNEY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from a rejection of claims
38–58. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

STATEMENT OF THE CASE

The present patent application concerns “controlling distribution of information related to digital items that are shared with users over a computer network.” Specification 1:7–8, filed March 16, 2012 (“Spec.”). Claims 38, 48, and 58 are independent. Claim 38 illustrates the claimed subject matter:

38. A method, performed at least in part by at least one hardware processor, for sharing digital items with communication identities, the method comprising:

receiving, from a user interface, first instructions to grant each communication identity of a group of communication identities access to a digital item;

enabling each communication identity of the group to access the digital item based on the first instructions;

receiving, from the user interface, second instructions to grant a first communication identity of the group access to view an annotation associated with the digital item;

enabling, by the at least one hardware processor, the first communication identity to view the annotation associated with the digital item based on the second instructions;

receiving, from the user interface, third instructions to deny a second communication identity of the group access to view the annotation associated with the digital item; and

denying, by the at least one hardware processor, the second communication identity access to view the annotation associated with the digital item based on the third instructions, while still enabling the second communication identity to access the digital item based on the first instructions.

Appeal Brief 16–17, filed February 3, 2015 (“App. Br.”).

REJECTIONS

Claims 38–58 stand rejected under 35 U.S.C. § 101 as directed to nonstatutory subject matter. Answer 10–11, mailed July 15, 2015 (“Ans.”).¹

Claims 38, 39, 41–43, 46–49, 51–53, and 56–58 stand rejected under 35 U.S.C. § 102(e) as anticipated by Siegel et al. (US 2011/0184828 A1; July 28, 2011) (“Siegel”). Final Office Action 4–8, mailed June 3, 2014 (“Final Act.”).

Claims 40, 44, 45, 50, 54, and 55 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Siegel and Feinberg et al. (US 2013/0239021 A1; September 12, 2013) (“Feinberg”). Final Act. 8–10.

ANALYSIS

Section 101 Rejection

With respect to this rejection, Appellant argues claims 38–58 together. *See* Reply Brief 8–11 filed September 15, 2015 (“Reply Br.”). We select claim 38 as representative of these claims and decide the appeal as to this rejection based on claim 38. *See* 37 C.F.R. § 41.37(c)(1)(iv) (“When multiple claims subject to the same ground of rejection are argued as a group . . . , the Board may select a single claim from the group . . . and may decide the appeal as to the ground of rejection with respect to the group . . . on the basis of the selected claim alone.”).

Appellant contends the Examiner improperly rejected claims 38–58 under 35 U.S.C. § 101. *See* Reply Br. 8–11. Appellant argues the Examiner did not “explain how [the] claims are ‘directed to’ an abstract idea” or

¹ The Examiner withdrew an earlier rejection of claims 38–47 under 35 U.S.C. § 101 in light of this rejection. Ans. 9.

consider the claims as a whole. Reply Br. 8, 9. According to Appellant, the claims do not concern an abstract idea, and even if they did, the claims would be patent eligible because the claims amount to significantly more than an abstract idea. Reply Br. 8–11.

We find Appellant’s arguments unpersuasive. Section 101 of the Patent Act provides that “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101. The Supreme Court has explained that this provision is subject to a long-standing, implicit exception: “[l]aws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. Pty. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014). The Court has set forth a two-part inquiry to determine whether this exception applies. First, we must determine if the claim at issue is directed to one of those patent-ineligible concepts. *Alice*, 134 S. Ct. at 2355. Second, if the claim is directed to one of those patent-ineligible concepts, we must consider the elements of the claim “both individually and as an ordered combination to determine whether the additional elements transform the nature of the claim into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (quotation marks omitted) (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 72 (2012)).

We first consider whether the Examiner properly concluded claim 38 is directed to an abstract idea. The Examiner concluded the plain language of claim 38 makes clear the claim is directed to the abstract idea of “basic data access control protocol.” See Ans. 10.

Appellant has not persuaded us that the Examiner erred. The Federal Circuit has explained that the abstract-idea inquiry requires “looking at the ‘focus’ of the claims, their “character as a whole” to determine if the claims are directed to an abstract idea. *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016). Claim 38 recites a method “for sharing digital items with communication identities” that uses “at least one hardware processor” and instructions received from a “user interface.” See App. Br. 16–17. The claimed method shares digital items by (1) granting a group of communication identities access to a digital item, (2) granting a particular communication identity access to an annotation associated with the digital item, and (3) denying another communication identity access to the annotation while still allowing the identity to access the digital item. See App. Br. 16–17. As the plain language of claim 38 makes clear, the focus of the claim is on controlling access to digital items and their associated annotations or, as the Examiner put it, the method is focused on a “basic data access control protocol.” Ans. 10.

The Federal Circuit has concluded that similar claims are directed to abstract ideas. For example, in *Smartflash LLC v. Apple Inc.*, the Federal Circuit agreed with a district court that the claims at issue recited methods “for controlling access to content data, such as various types of multimedia files, and receiving and validating payment data.” *Smartflash LLC v. Apple Inc.*, No. 2016-1059, 2017 WL 786431, at *4 (Fed. Cir. Mar. 1, 2017) (nonprecedential). The Federal Court concluded these claims were “directed to the abstract idea of conditioning and controlling access to data based on payment.” *Smartflash*, 2017 WL 786431, at *4. Similarly, in *Prism Techs. LLC v. T-Mobile USA, Inc.*, the Federal Circuit concluded claims reciting

systems and methods of controlling access to protected computer resources were directed to the patent-ineligible abstract idea of “providing restricted access to resources.” *Prism Techs. LLC v. T-Mobile USA, Inc.*, No. 2016-2031, 2017 WL 2705338, at *1–2 (Fed. Cir. June 23, 2017) (nonprecedential). And in *Ultramercial, Inc. v. Hulu, LLC*, the Federal Circuit concluded claims that included the steps of “restricting public access to media,” “allowing the consumer to access to the media,” and “allowing the consumer access to the media if the ad is interactive” were also directed to an abstract idea. *See Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 714–15 (Fed. Cir. 2014).

The method for sharing digital items recited in claim 38 is not meaningfully different from the claimed methods of controlling data access discussed in *Smartflash*, *Prism Techs*, and *Ultramercial*. This is sufficient to establish claim 38 is directed to an abstract idea. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1334 (Fed. Cir. 2016) (explaining that when determining whether claims are directed to an abstract idea, “both this court and the Supreme Court have found it sufficient to compare [the] claims at issue to those claims already found to be directed to an abstract idea in previous cases”); *see also Amdocs (Israel) Limited vs. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016) (explaining that the “decisional mechanism courts now apply” for deciding if claims are directed to an abstract idea “is to examine earlier cases in which a similar or parallel descriptive nature can be seen”).

Despite these similarities, Appellant contends claim 38 is not directed to an abstract idea “as evidenced by the recited elements . . . and the fact that [it does] . . . not threaten to ‘tie up’ the alleged abstract idea of ‘data access

control.” Reply Br. 8. Appellant also argues that claim 38 is not directed to an abstract idea because the claim does not concern “a fundamental economic practice, a method of organizing human activities, an idea of itself or a mathematical relationship.” Reply Br. 8 (quotation marks omitted). Appellant has provided no persuasive evidence or reasoning to support these arguments. Appellant has not identified the “recited elements” that allegedly establish claim 38 is directed to patent-eligible subject matter, nor has Appellant adequately explained why claim 38 does not preempt the identified abstract idea. *See* Reply Br. 8–9. In any event, even if we were to agree that claim 38 does not “threaten to ‘tie up’ the alleged abstract idea of ‘data access control,’” the fact that the claim does not preempt the concept of “data access control” does not make the claim patent eligible. *See Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (“While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.”); *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015) (“[T]hat the claims do not preempt all price optimization or may be limited to price optimization in the e-commerce setting do not make them any less abstract.”). And as noted above, the Federal Circuit has concluded that similar claims are directed to an idea. Nothing in claim 38 requires a different outcome.

We next consider whether the Examiner correctly concluded claim 38 does not include an “inventive concept—i.e., an element or combination of elements that is sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.” *Alice*, 134 S. Ct. at 2355 (quotation marks omitted) (quoting *Mayo, Inc.*, 566 U.S.

at 72–73). The Examiner explained claim 38 does not include an “inventive concept” because claim 38 simply recites performing an abstract idea using a generic computer and does not improve “the functioning of the computer itself” or add “meaningful limitations beyond generally linking the use of an abstract idea to a particular technological environment or field of use.” Ans. 11 (emphasis omitted).

We agree. Claim 38 recites performing the abstract idea with “at least one hardware processor” and instructions received from “a user interface.” See App. Br. 16–17. Appellant’s written description and the cited art establish that these components were well known to those of ordinary skill in the art, as were the recited “digital items” and “communication identities.” Appellant’s written description discloses that it was well known to “install communications software necessary to access and use [an] instant messaging service” and that an instant messaging “participant list . . . includes . . . communications identities.” Spec. 1:13–14. Feinberg discloses that a hardware platform can “include one or more processors” and depicts various aspects of an instant messaging user interface. Feinberg ¶ 37, Figs. 4–27. And Siegel explains that “distribution of annotations of digital works may be limited to users having an appropriate authorization credential that, when presented . . . and validated enables the user to receive the requested annotation.” Siegel ¶ 47. Claim 38 simply recites using known elements to perform “conventional steps, specified at a high level of generality, which is insufficient to supply an inventive concept.” *Ulramercial*, 772 F.3d at 716 (quotation marks omitted) (quoting *Alice*, 134 S. Ct. at 2357).

Appellant argues that claim 38 recites an inventive concept because the claim “provide[s] a solution to problems specifically arising in the realm

of computerized systems and networks” and “enhances the functionality of computer technology in order to overcome the identified technological problem.” Reply Br. 10. But as noted above, claim 38 recites using known elements to perform conventional steps, which is not enough to provide the necessary inventive concept. An inventive concept “requires more than simply stating an abstract idea while adding the words ‘apply it’ or ‘apply it with a computer.’” *Versata Dev. Grp., Inc. v. SAP Am., Inc.*, 793 F.3d 1306, 1332 (Fed. Cir. 2015) (quoting *Alice*, 134 S. Ct. at 2358). And “the prohibition on patenting an ineligible concept cannot be circumvented by limiting the use of an ineligible concept to a particular technological environment.” *Versata*, 793 F.3d at 1332.

For the above reasons, we sustain the Examiner’s rejection of claims 38–58 under 35 U.S.C. § 101.

Section 102 and 103 Rejections

Appellant contends Siegel does not disclose “receiving, from the user interface, third instructions to deny a second communication identity of the group access to view the annotation associated with the digital item” as recited in claim 38 and similar limitations recited in independent claims 48 and 58. *See* App. Br. 12–13, 17; Reply Br. 4–5. Appellant argues the Examiner improperly found Siegel inherently discloses this limitation. *See* Reply Br. 4–5.

We find Appellant’s arguments persuasive. The Examiner found “Siegel clearly discloses the idea of denying access to an annotation . . . if the [associated] authorization credential . . . is not valid.” Ans. 15 (citing Siegel ¶¶ 37, 47, 72). The Examiner found the claimed limitation “an

inherent element to the access control mechanism taught by Siegel.” Ans. 15. But the cited portions of Siegel simply disclose that a user may supply authorization credentials that provide access to the user’s annotations. *See* Siegel ¶ 72. If another user presents the proper authorization credential, Siegel’s system grants that user access to the annotation. *See* Siegel ¶ 47. This process does not inherently require “receiving, from the user interface, third instructions to *deny* . . . access to view the annotation,” as required by claim 38.

Based on the record before us, we do not sustain the Examiner’s anticipation rejection of independent claims 38, 48, and 58 and dependent claims 39, 41–43, 46, 47, 49, 51–53, 56, and 57. We also do not sustain the Examiner’s obviousness rejection of dependent claims 40, 44, 45, 50, 54, and 55, as the rejection does not address the deficiency discussed above. If prosecution continues, the Examiner remains free to consider whether the disputed “receiving” limitation would have been *obvious* in light of Siegel or any other prior art references.

DECISION

We affirm the Examiner’s rejection of claims 38–58 under 35 U.S.C. § 101. We reverse the Examiner’s anticipation rejection of claims 38, 39, 41–43, 46–49, 51–53, and 56–58 and obviousness rejection of claims 40, 44, 45, 50, 54, and 55. Because we have affirmed at least one ground of rejection with respect to each claim on appeal, we affirm the Examiner’s decision. *See* 37 C.F.R. § 41.50(a)(1).

Appeal 2015-008281
Application 13/423,001

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED